

Amendments to the Drawings:

1. The attached sheet of drawings, 3/18, includes corrections to typographical errors in reference characters in Figures 3C and 3D. This sheet replaces the original sheet 3/18. An annotated sheet is not required for mere changes to reference characters, and has not been provided for these sheets. *See* MPEP 608.02(v).
2. The attached sheet of drawings, 5/18, includes changes to Figures 5A and 5B. This sheet replaces the original sheet 5/18.
3. The attached sheet of drawings, 6/18, includes removal of and changes to reference characters in Figure 6A. This sheet replaces the original sheet 6/18.
4. The attached sheet of drawings, 7/18, includes additional reference characters in Figures 7A and 7C, and changes to a reference character in Figure 7B. This sheet replaces the original sheet 7/18.
5. The attached sheet of drawings, 9/18, includes removal of a reference character in Figure 9D. This sheet replaces the original sheet 9/18.
6. The attached sheet of drawings, 10/18, includes changes to reference characters in Figures 10A and 10C. This sheet replaces the original sheet 10/18. An annotated sheet is not required for mere changes to reference characters, and has not been provided for these sheets. *See* MPEP 608.02(v).

7. The attached sheet of drawings, 12/18, includes an additional reference character and changes to a reference character in Figure 12A. This sheet replaces the original sheet 12/18.

8. The attached sheet of drawings, 18/18, includes additional reference characters in Figures 19A, 19D and 20. This sheet replaces the original sheet 18/18.

REMARKS

Claim of Priority

A claim of Domestic Priority to U.S. Provisional Applications No. 60/444,326 and No. 60/444,345 was made in the combined Declaration and Power of Attorney for this Application and was recorded on the Filing Receipt. Applicants now withdraw their claim of Domestic Priority to the latter aforementioned Provisional Application – No. 60/444,345.

Amendments to the Specification

The specification has been amended to correct drafting errors and to provide clarity. No new matter has been added. The numbered paragraphs below correspond to the numbered amendments to the specification provided on pages 2-9 of this amendment.

1. The first line of paragraph [001] of the specification, as originally filed, has been amended to specify that Applicants are claiming the benefit of U.S. Patent Application S.N. 60/444,326, filed 1/31/2003. Applicants' claim of benefit was properly made at the time of filing and is recorded on the filing receipt.
2. The last line of paragraph [030] of the specification, as originally filed, has been amended to correct a grammatical error.

3. The next to last line of paragraph [035] of the specification, as originally filed, has been amended to correct a typographical error.
4. The first and last lines of paragraph [037] of the specification, as originally filed, have been amended to correct grammatical errors.
5. The second line of paragraph [039] of the specification, as originally filed, has been amended to correct a grammatical error. Furthermore, the last sentence of this paragraph has been amended to improve the clarity of the description of Figures 4A and 4B. Support for the clarification is found in Figures 4A and 4B. Inspection of Figure 4B shows the blade 320 to be eccentrically mounted on an axle which is part of the bearing block 330. It is apparent from Figures 4A and 4B that when the blade 320 is at peak extension, the portion of the blade with the largest radius, as measured from the axle, will be exposed. As the blade 320 is rotated as shown by arrow 420, the part of the blade with the largest radius will have the highest velocity.
6. The new paragraph has been added to provide a detailed description of Figures 5A and 5B. This detailed description is based on Figures 5A and 5B, as originally filed, and on the descriptions of the elements of closely related Figures 4A and 4B, provided in paragraphs [038] and [039], and Figures 3A-3D, provided

in paragraphs [034] through [037], as originally filed. No new matter has been added.

7. The last line of paragraph [043] of the specification, as originally filed, has been amended to improve the clarity of the description of Figures 7A-7D. Support for the clarification is found in Figures 7A-7D. Inspection of Figure 7C and 7D shows the blade 710 to have a non-circular shape, where a "fin" 720 on the edge of the blade represents the part of the blade edge with the largest radius. As the blade 710 is rotated as shown by arrow 730 in Figure 7D, the part of the blade 710 with the largest radius will have the highest velocity. Therefore, the fin 720 will have the highest velocity.

8. The last line of paragraph [045] of the specification, as originally filed, has been amended to correct grammatical errors and to improve the clarity of the description of the actuation of a cutting event. Furthermore, the last sentence has also been amended to improve the clarity of the description of element 930, shown in Figures 9A-9D – element 930 is now referred to as a "driver." The term "driver" more accurately reflects the role of the element in imparting rotational and linear motion to the blade 900 relative to the bearing block 920, as described in paragraph [045] and shown in Figures 9A-9D.

9. The last line of paragraph [048] of the specification, as originally filed, has been amended to correct a grammatical error. Furthermore, a brief description of the views shown in Figures 12A-12C has been added. This description is based on the closely related views of Figures 3A-3D, described in paragraph [034] of the specification, as originally filed. No new matter has been added.

10. The first line of paragraph [049] of the specification, as originally filed, has been amended to correctly describe Figure 13A, as originally filed. The phrase "relative to a housing 1310" has been deleted, since the tip of the housing 1310 and the blade 1330 are clearly shown to be monopolar (having the same potential) in Figure 13A. The last line has been amended to add the phrase "or at ground", which is clearly shown in Figure 13B. No new matter has been added.

11. The second line of paragraph [052] of the specification, as originally filed, has been amended to correct a grammatical error.

12. The fourth line of paragraph [053] of the specification, as originally filed, has been amended to correct grammatical errors. An extra sentence has been added at the end of the paragraph, providing a description of the view shown in Figure 20. Support for the latter amendment is found in Figures 19A and 20. No new matter has been added.

13. The second line of paragraph [055] of the specification, as originally filed, has been amended to correct grammatical errors. Furthermore, the second sentence has been amended to improve the clarity of the description – the term “relative” has been replaced with the parenthetical qualification “relative to the prior art”. The meaning of the term “relative” is apparent from the context.

14. The Abstract, as originally filed, has been amended to correct a typographical error.

Amendments to the Drawings

The drawings have been amended to correct drafting errors and to provide clarity. No new matter has been added. The numbered paragraphs below correspond to the numbered amendments to the drawings provided on pages 14-15 of this amendment.

1. In amended FIG. 3C, “300” has been corrected to “310”. In amended Figure 3D, “30” has been corrected to “310”. Support for these changes is found in paragraph [034] of the specification, as originally filed.

2. In amended Figures 5A and 5B, the previously omitted reference characters 320, 330, AXLE 350, 380 and 420 have been added. Furthermore,

the previously omitted arrow for the direction of rotation has been added to Figure 5B. Support for these additions is found in closely related Figures 3A-3D, 4A and 4B, as originally filed. No new matter has been added.

3. In amended Figure 6A, the reference character "610" has been added to the lead line labeled "Bearing Block". Support for this change is found in paragraph [042] of the specification, as originally filed. The potentially confusing reference character "600" and associated lead line on the left of Figure 6A have been removed.

4. In amended Figure 7A, the reference character "700" has been added to indicate the housing. In amended Figure 7B, the callout has been corrected to correctly identify the "Exposed Blade Element 720". In amended Figure 7C, the callout "710" has been added to indicate the blade. Support for these corrections and additions is found in paragraph [043] of the specification, as originally filed. No new matter has been added.

5. In amended Figure 9D, the reference character "940" and associated lead line have been removed.

6. In amended Figure 10A, "1000" has been added to the reference character "Bearing Block". In amended Figure 10C, "1010" has been added to the reference character "Blade". Support for these changes is found in paragraph [046] of the specification, as originally filed. No new matter has been

added.

7. In amended Figure 12A, a typographical error has been corrected in the reference character "Blade Separation". The reference character 1200 has been added to comport with the additional text which provides a brief description of the views shown in Figures 12A-12C, as discussed above in the amendments to the specification. No new matter has been added.

8. In amended Figure 19A, reference character 1930 has been added to indicate the housing. In amended Figures 19D and 20, reference characters 1910 and 1930 have been added to indicate the shaft and housing, respectively. Support for these additions is found in paragraph [053] of the specification, as originally filed. No new matter has been added.

Amendments to the Claims

Claims 1, 4-5, 7-9, 10-11, 14-25 and 27-29 remain in this application. Claims 2-3, 6, 10, 12-13 and 26 have been canceled. Claims 1, 4, 8, 11, 20 and 23-25 have been amended. New claims 27-29 have been added. Claim 1 is an independent claim.

In the Office Action dated May 16, 2008: claims 4, 6 and 23-26 were rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite; claims 1, 4-11, 15 and 20 were rejected under 35 U.S.C. 102(b) as allegedly

being anticipated by U.S. Patent No. 5,591,186 to Wurster et al.; claims 1 and 23-26 were rejected under 35 U.S.C. 102(b) as allegedly being anticipated by U.S. Patent No. 5,101,564 to Matthai et al.; claim 14 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Wurster et al.* in view of U.S. Patent No. 6,451,017 to Moutafis et al.; and claims 16-19 and 21-22 were rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Wurster et al.* in view of substitution of known equivalents.

Applicants note that the Examiner, in his rejection of claims 1 and 23-26 under 35 U.S.C. 102(b) in item 6 on page 5 of the Office Action, appears to have confused U.S. 5,101,564 to Melter and U.S. 5,468,247 to Matthai et al. The references cited by the Examiner are consistent with U.S. 5,468,247 to Matthai et al.; consequently, Applicants have responded to the rejection based on U.S. 5,468,247 to Matthai et al.

Section 112 Rejections

In response to the rejections, Applicants have made the following amendments to more distinctly describe the subject matter being claimed.

Applicants have amended claim 4 to require a "roughly cylindrical" housing, as shown in Figures 1A-1B and 3A-3B.

Applicants have amended claims 23-25 to be clear that it is configurations of the system that are being claimed.

Section 102 Rejections

In response to the rejections, Applicants have made the following amendments to more clearly distinguish Applicants' invention from the cited art.

Claim 1 has been amended to require a bearing block, as shown in Figures 3A-10D. Further, claim 1 has been amended to require the cutting element to be an eccentric disc rotatably connected to the bearing block by an axle, wherein the cutting element is configured to rotate eccentrically, as shown in Figures 3A-8D. Furthermore, claim 1 has been amended to require the cutting element, the axle and the bearing block to be configured such that a cutting edge of the disc is exposed beyond the end of the bearing block distal to the housing for only part of the eccentric rotation. The latter configuration is shown in Figures 3A-8D. Applicants have also amended the description of the drive mechanism to be consistent with the aforementioned amendments to claim 1.

Wurster et al. does not disclose: (1) a cutting element that is an eccentric disc configured to rotate eccentrically; and (2) a cutting element attached to a bearing block, in turn attached to the end of a housing, so that a cutting edge of the disc is exposed beyond the end of the bearing block distal to the housing for only part of the eccentric rotation.

In view of the above remarks, Applicant respectfully asserts that claim 1 and dependent claims are allowable over *Wurster et al.*

U.S. 5,468,247 to Matthai et al. describes a reciprocating saw with a constant cutting radius. See Figure 1 and Figure 9, in which the axis of rotation is marked by the intersection of lines B3 and B4. *Matthai et al.* does not disclose a cutting element that is an eccentric disc configured to rotate eccentrically. Further, *Matthai et al.* in col. 4, lines 45-59 discloses that the blade is exposed beyond the cap 80 at all times. See Figure 1. *Matthai et al.* does not disclose a cutting edge exposed beyond the cap for only part of the blade rotation. Furthermore, *Matthai et al.* at col. 2, line 67 through col. 3, line 10 discloses only cutting rates and the type of materials that are cut. *Matthai et al.* does not disclose either (1) variable cutting depth or (2) variable incision ramp angle. *Matthai et al.* does not disclose any of variable cutting depth, angle or rate determined by the eccentricity of the cutting element, as claimed by Applicant in amended claims 23-25.

In view of the above remarks, Applicant respectfully asserts that claim 1 and dependent claims are allowable over *Matthai et al.*

Section 103 Rejections

As argued above, claims 14, 16-19 and 21-25 are allowable due to their dependence on allowable amended claim 1. Therefore, the rejection of claims 14, 16-19 and 21-25 under section 103(a) is moot.

Amended Claims 8, 11 and 20 and New Claims 27-29

Claims 8, 11 and 20 have been amended to be consistent with amended claim 1.

Support for the new claims is found in the specification as originally filed. The eccentrically mounted disc of claim 27 is shown in Figures 3A-6D, 12A-C and 14-18. The circular disc of claim 28 is most clearly shown in Figures 3D, 4B, 5B, 6B and 6D. The elliptical disc of claim 29 is shown in Figures 8C-D.

Applicants respectfully assert that claims 8, 11, 20 and 27-29 are allowable due to their dependence on claim 1.


CONCLUSION

Applicants have explained the differences between the claims and the cited references, and believe the claims are in condition for allowance.

If any further questions should arise prior to a Notice of Allowance, the Examiner is invited to contact the attorney at the number set forth below.

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Respectfully submitted,



David H. Jaffer
Reg. No. 33,243
Customer No. 27498

PILLSBURY WINTHROP SHAW PITTMAN LLP
Intellectual Property Group
P. O. Box 10500
McLean, VA 22102
Tel. No. (650) 233-4510
Fax No. (703) 770-7901